

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
(Attorney Docket No. 14825US02)**

In the Application of:

Jeyhan Karaoguz

Serial No.: 10/675,443

Filed: September 30, 2003

For: SERVER ARCHITECTURE
SUPPORTING A PERSONAL MEDIA
EXCHANGE NETWORK

Examiner: Melvin H. Pollack

Group Art Unit: 2445

Conf. No.: 5634

Electronically filed on December 7, 2010

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

This Reply Brief responds to the Examiner's Answer mailed on October 7, 2010. Claims 1-30 are pending in the present application. This Reply Brief is timely filed within the period for reply, which ends on December 7, 2010.

REMARKS

The Appellant will now address certain issues raised in the “Response to Arguments” section of the Answer.

The Examiner states as follows regarding the alleged motivation for combining Dynarski and West:

In response to appellant's argument that there is no teaching, suggestion, or motivation to combine the references (Pp. 7-8 and 16-18), the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the articulated reasoning does not need to be a detailed thesis as to the motivation to combine, particularly when the secondary art addresses an issue of the primary art's concern.

Dynarski is about setting up communications with devices by, at the very least, being concerned with address association and assignment, as argued in the prior office action (Final action, Paras. 9-10). Appellant concedes that Dynarski teaches at least this much (remarks, P. 11). More particularly, it is a goal of Dynarski to improve the initiation of communications (Dynarski, abstract) by better handling address management steps (Dynarski, col. 1, line 55 - col. 2, line 30). The motivation to combine comes from a person of ordinary skill in the art's motivation to seek out other solutions to this problem to learn improvements. West is also concerned with the goal of improving upon the initiating of communications (West, abstract) by improving address management (West, col. 1, line 1 – col. 4, line 40) in ways that one of ordinary skill in the art would learn from. Since West improves on Dynarski's techniques and helps solves Dynarski's problems, there is sufficient motivation to combine based upon the art's shared goals.

(Answer, pp. 6-7.) Appellant disagrees with the Examiner's characterization of the references, as well as the Examiner's characterization of Appellant's alleged concessions regarding the teachings of Dynarski. In the above passage, the Examiner provides an unreasonably broad characterization of the "goals" and teachings of the cited references in an apparent attempt to create a motivation for combining the cited references in the manner proposed by the Examiner. According to the Examiner, "it is a goal of Dynarski to improve the initiation of communications (Dynarski, abstract) by better handling address management steps (Dynarski, col. 1, line 55 - col. 2, line 30)." More accurately, Dynarski is directed to a method "of automatically locating and connecting a mobile wireless communications device to a packet-switched network such as the Internet." (Dynarski, Abstract; *see also, id.*, 1:7-12 ("[T]he invention relates to a process by which a mobile communications device, for example, a laptop computer equipped with a cellular telephone modem, is located and communication between the device and a terminal on an IP network is initiated."); *see also, id.*, 1:58-2:26.) Likewise, the Examiner alleges that "West is also concerned with the goal of improving upon the initiating of communications (West, abstract) by improving address management" In actuality, West focuses on the issue of providing Internet access to hotel guests. (*See, e.g.*, West, 2:54-59 ("It is therefore desirable to provide methods and apparatus by which each of the properties in a major hotel chain may provide high speed Internet access to each of its guest rooms in a secure, inexpensive, and reliable manner without undue administrative burdens on the individual properties."); *see also, id.*, 1:61-4:8.) Accordingly, it is not understood why a person of ordinary skill in the art would modify Dynarski's teachings regarding "automatically locating and connecting a mobile wireless

communications device to a packet-switched network such as the Internet" with West's teachings that are directed to the management of IP addresses in hotels. West simply is not concerned with locating and connecting to mobile devices. Rather, West is focused on allowing hotel guests to connect to the Internet by temporarily associating the internal network IP address of a guest room with a global IP address from a pool of such addresses that are available to the hotel. (See, e.g., West, 1:59-2:23.)

Accordingly, Appellant maintains that the Examiner has not established a *prima facie* case of obviousness and the Board should withdraw the rejections based on combining Dynarski and West.

Next, the Examiner states as follows regarding the rejection of independent claims 1, 11 and 21:

Appellant argues that Dynarski does not expressly disclose assigning, by said headend, an address to said first device coupled to said communication network (Pp. 8-12). In response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., the scope of the claims) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As stated in the final action and advisory action, one must give the claims their broadest reasonable interpretation in light of the common meaning, the definitions within the specification, and the knowledge of one of ordinary skill in the art. One must also compare this area to the art as a whole, based not on the particular phrasing of the claims or art but upon the common structure and function of the claims.

In the particular case, the assigning and associating steps are interpreted as developing a relationship of any type between an address of any form and a device of any form. The claims do not specify the relationship, describe the function of the

assigning step or describe how the assignment is ultimately used. Therefore, relationship may be considered broadly. This interpretation is bolstered by the definitions provided (specification, Paras. 49, 63-66, and 72-73). Even if we were to accept as the interpretation a narrower definition of static/dynamic IP addressing, the limitation would still be shown by relationships such as locating and identifying devices, mapping IP addresses, and performing steps to initiate communication.

In this case, the headend cannot always know the address because the device may move around or be inactive. To handle this situation, the device tells the headend a device. The headend then populates the memory of the communication server (in this case, #28 and #30), such that the headend may later retrieve and use this information to locate the device. That the servers do much of the processing is not inconsistent with the claims as currently drawn.

Appellant errs in interpreting his claims so narrowly and in not viewing the art as a whole, but instead focusing on the times when the communication server reports to the headend.

(Answer, p. 8-9.)¹ Appellant disagrees with the Examiner. In the above passage, the Examiner states "the headend cannot always know the address because the device may move around or be inactive. To handle this situation, the device tells the headend a device. The headend then populates the memory of the communication server (in this case, #28 and #30), such that the headend may later retrieve and use this information to locate the device." Initially, it is noted that the second sentence is incomplete and unintelligible. In any event, the Examiner provides absolutely no citations to support his interpretation of Dynarski. This is because Dynarski does not actually include any such teaching. Accordingly, Appellant maintains that claim 1 is patentable at least because the proposed combination of Dynarski and West fails to disclose or suggest at least

¹ Emphasis added except with noted otherwise.

"assigning, by said headend, an address to said first device coupled to said communication network," as required by claim 1. *See In re Royka*, 490 F.2d 981 (CCPA 1974) (to establish *prima facie* obviousness of a claimed invention, **all the claim features must be taught or suggested by the prior art.**)

Independent claims 11 and 21 are similar in relevant aspects to claim 1. Accordingly, independent claims 11 and 21 are also allowable over Dynarski and West at least for the reasons stated above with respect to claim 1.

Next, the Examiner states as follows regarding the rejection of independent claims 1, 11 and 21:

Appellant then argues that Dynarski does not expressly disclose, "in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned addresses and/or said identifier of said first device to at least one communication server coupled to said communication network (Pp. 12 -15)." Appellant is reminded that claims must be given their broadest reasonable interpretation, particularly in regards to timing. As for the length of the cited limitation, it is acceptable because it is a unified section and not unreasonable in length. There is no requirement that the examiner is limited to only a paragraph or column.

Again, appellant seems to be under the impression that, despite the device interacting only with the headend, the communication server acts on its own. In doing so, appellant glosses over communications from the headend to the server, i.e. the access-request message that includes transferred assigned addresses and/or identifiers. Without this request, the server would never provide an accept or response message, let alone one with the information the headend desires. This message is in response to the device because the headend makes the request in response to a communication from the device, i.e. a request for connection that includes the information.

(Answer, p. 9.) Appellant disagrees with the Examiner. In rejecting the claims, the Examiner equates Dynarski's mobile device 14 with the "first device" recited in Appellant's claims. (See, e.g., Final Office Action, ¶ 9; see also, Answer, ¶ 3.b.) However, nothing in the Examiner's above response, nor in the cited passages of Dynarski discloses or suggests that "in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network," as recited in Appellant's claim 1. In the above passage, the Examiner states:

[A]ppellant glosses over communications from the headend to the server, i.e. the access-request message that includes transferred assigned addresses and/or identifiers. Without this request, the server would never provide an accept or response message, let alone one with the information the headend desires. **This message is in response to the device because the headend makes the request in response to a communication from the device, i.e. a request for connection that includes the information**

(Answer, p. 9.) Appellant, notes however, that home agent 22 (the alleged headend) does not issue the Access-Request message in response to a communication from the mobile device 14 (the alleged first device). Instead, Dynarski clearly teaches that home agent 22 issues the access-request message when it receives an IP packet from a terminal 10 on the network 12, which is destined for the mobile device 14.

A presently preferred method by which a mobile wireless communications device (e.g., laptop computer 14) is automatically located and connected to the packet-switched network 20 and ultimately the remote terminal 10 will now be described. **First, an Internet Protocol (IP) packet from a terminal 10 on the network 12 and destined for the device 14 is relayed by router 18 onto the WAN 20 where it is**

received by the home agent 22. At this point, the home agent 22 detects that it does not have a mobility binding record which can be used to route the packet to the device 14, since, for example, there is no current IP session in progress between the device 14 and the home agent 22. Instead of dropping the packet, as would normally be the case in the prior art, **the home agent then transmits an Access-Request message to the authentication server 28 for authentication. The Access-Request message includes the destination IP address for the wireless device 14 that was included in the IP packet from the terminal 10 on the network.** The purpose of the Access-Request message is to authenticate the user who owns device 14 to be sure that they are allowed to receive the call, e.g., that they are a current subscriber with the wireless network 40, their bill is not in arrears, etc.

(See, e.g., Dynarski, 6:55-7:8.) As this passage makes clear, the Access-Request message is issued in response to a communication from the terminal 10, not the device 14 as is apparently alleged by the Examiner. Accordingly, Appellant maintains that claim 1 is patentable because the proposed combination of Dynarski and West fails to disclose or suggest at least “in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network,” as recited in Appellant’s claim 1.

Independent claims 11 and 21 are similar in relevant aspects to claim 1. Accordingly, independent claims 11 and 21 are also allowable over Dynarski and West at least for the reasons stated above with respect to claim 1.

The Examiner states as follows regarding the rejection of claim 2:

Regarding claim 2, appellant argues that Dynarski does not expressly disclose that detecting occurs prior to the assigning, but rather occurs afterwards (Pp. 18 - 20). In this case,

appellant misapplies the understanding of the communication; just because a device sends an IP packet does not mean that the assignment has occurred. In fact, the next steps after the home agent receives the packet appellant mentions is that it detects whether it has a mobility binding record and acts accordingly by moving to the detection phase and then to the assignment phase (col. 6, line 55 - col. 7, line 60).

(Answer, pp. 10-11.) Appellant disagrees. As was detailed in the Appeal Brief, e.g., pp. 18-20, the IP address is assigned to the device 14 before the device connects to the network, not after a detection as required by claims 2, 12 and 22. Accordingly, Appellant maintains that claims 2, 12 and 22 are allowable for the reasons set forth in the Appeal Brief.

The Examiner states as follows regarding the rejection of claims 4, 5, 9 and 10:

Regarding claims 4, 5, 9, and 10, appellant argues that the examiner's burden to explain how a passage is disclosed by a reference cannot be met if an examiner cites to an unreasonably lengthy passage of 1.5 columns long (pp. 20 — 22, 25-27). The examiner agrees that the requirement requires clarity but there is no ruling that any particular citation length is *prima facie* verboten, particularly if the entire cited section is focused on one area of detail. Appellant has not shown any indication that he has attempted to read the passage, let alone that there was any confusion as to which structure or function the examiner was referring to. At any rate, the cited passage is only eight paragraphs long and is only a small portion relative to the size of the art. More pertinent is that every paragraph deals in some way with the limitation of registering addresses with the communication server. If the board were to add a length restriction to examiner analysis, it would keep examiners from citing all the relevant evidence of obviousness and keep examiners from discussing the art as a whole.

(Answer, p. 11.) Appellant disagrees with the Examiner's characterization of Appellant's arguments. Appellant does not contend that there is a length limit on prior art citations. Rather, Appellant objects to the mere citation to passages of the reference

without any explanation of how or where the specific claim limitation at issue is allegedly disclosed by the cited passage. The length of the cited prior art passages compounds the deficiency of the Examiner's rejections. Without a more precise explanation of where and how the claim limitations are allegedly disclosed, the rejections of claims 4, 5, 9 and 10 is improper and should be reversed. See, e.g., *In re Wada and Murphy*, Appeal 2007-3733 (A proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention – **including all its limitations** – with the teaching of the prior art"); see also *Ex Parte Gulliver* 2009 WL 728292 (B.P.A.I. 2009 ("The Examiner's rejection . . . fails to address, let alone show the obviousness of, the limitation . . . We will not resort to speculation, unfounded assumptions, or hindsight reconstruction to correct this deficiency. . . . We reverse the rejections under § 103.") The same is true with regard to the rejections of claims 14, 15, 19, 20, 24, 25, 29 and 30.

The Examiner states as follows regarding the rejection of claims 6-8:

Regarding claims 6-8, appellant makes the same argument in regards to a lengthy passage of one paragraph (Pp 22-25). The appellant argues that a single paragraph citation for a claim with a single limitation warrants a detailed analysis by the examiner to connect the dots. As shown above, the test is not whether the passage is too long or the examiner's citations are too short but whether the application is clear. Here, the passage clearly shows a second device receiving information about a first device, and therefore needs no further clarification on how to apply the paragraph.

(Answer, pp. 11-12.) Examiner disagrees and maintains that the rejection is improper because the Examiner fails to provide a sufficient explanation of how or where the

specific claim elements are allegedly disclosed in the lengthy passages cited by the Examiner. The same is true with regard to the rejections of claims 16-18 and 26-28.

CONCLUSION

For at least the foregoing reasons, Appellant submits that claims 1-30 are in condition for allowance. Reversal of the Examiner's rejection and issuance of a patent on the application are therefore requested.

The Commissioner is hereby authorized to charge any fees or credit any overpayment in connection with this filing to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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